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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/456,793	12/08/1999	Christopher L. Knauf	MEDIDNA.049A	6923

30948 7590 11/01/2005
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EXAMINER

NGUYEN, MAIKHANH

ART UNIT PAPER NUMBER

2176

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/456,793

Applicant(s)

KNAUFT ET AL.

Examiner

Maikhanh Nguyen

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: RCE filed 09/09/2005 to the original application filed 12/08/1999.
2. Claims 1-27 are currently pending in this application. Claim 19 has been amended. Claims 1, 12, 19, and 25 are independent claims.

Request Continuation for Examination

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/09/2005 has been entered.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-18 and 25-27 are rejected under 35 U.S.C. 101 because the claimed invention, appearing to be comprised of software only without claiming

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associated computer hardware required for execution, is not supported by either a specific and substantial asserted utility or a well established utility.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Judd et al.** (U.S. 6,360,215 – filed 11/1998) in view of **Kirsch et al.** (U.S. 5,920,854 – issued 07/1999).

As to claim 12

- a. Judd teaches a method of providing index information for secure graphical or audio objects (*see Abstract*), the method comprising:
- (i) reading index information (*searching the index; col.3, lines 7-8*) that is associated with a secure graphical or audio object (*col.3, lines 33-45*), wherein the index information is structured for use in an index database of a search engine system (*col.3, lines 59-67*), and wherein

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the search engine system does not have full access to the secure graphical or audio object (*col.3, lines 21-32*); and

- (iii) transmitting the index information to the search engine system, wherein the obfuscated index information is for use in the index database of the search engine system (*see search engine discussion beginning at col. 16, line 30*).

- b. Judd, however, does not specifically teach “*obfuscating at least a portion of the index information so that the intelligibility of the index information is reduced.*”
- c. Kirsch teaches obfuscating at least a portion of the index information so that the intelligibility of the index information is reduced (*col.10, lines 8-65 and item 70 in fig.3*).
- d. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the feature from Kirsch in the system of Judd because it would have provided the capability for effectively filtering performance of the term filter may be dynamically improved to focus more on terms likely to carry contextual significant.

As to claim 13

- a. Judd does not specifically teach “*a portion of the index obfuscated information.*”
- b. Refer to claim 12 above for rejection the use of obfuscation.

As to claim 14

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Judd teaches customizing, is based at least in part upon the contents of the index characteristics of one or more the search engine systems (*col.10, lines 19-44*).

As to claim 15

Judd teaches a HyperText Markup Language file (*Hypertext Markup Language; col.7, lines 19-31*).

As to claim 16

Judd teaches a bitmap image (*col.1, lines 55-57*).

As to claim 17

Judd teaches the secure graphical object is a multimedia presentation (*col.7, lines 10-31 and col.17, lines 25-27*).

As to claim 18

Judd teaches the graphical object is a stream media file (*col.6, lines 2-5*).

As to claim 1

The rejection of claim 12 above is incorporated herein in full. Additionally, Judd further teaches converting at least a portion of a secure audiovisual object into index information (*col.10, lines 19-36 and see fig. 2b*).

As to claims 2 and 3-5

They incorporate the same limitations as in claim claims 13 and 20-22 above, and are rejected along the same rationale.

As to claim 6

Judd teaches music (*col.1, lines 39-52*).

As to claim 7

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Judd teaches identifying one or more words in the lyrics of the music (*col.1, lines 39-52*).

As to claim 8

It incorporates the same limitations as in claim 17 above, and is rejected along the same rationale.

As to claim 9

Judd teaches reading close captioned information that is associated with the audiovisual object (*col.5, lines 19-41*).

As to claim 10

Judd teaches a streaming media file (*col.6, lines 2-5*).

As to claim 11

It incorporates the same limitations as in claim 9 above, and is rejected along the same rationale.

As to claim 25

- a. The rejection of claim 12 above is incorporated herein in full. Additionally, claim 25 further recites “*dynamically generating an electronic document based at least in part upon the contents of the index information; and transmitting the electronic document to the search engine system.*”
- b. Kirsch teaches dynamically generating an electronic document based at least in part upon the contents of the index information (*col.4, lines 17-27*); and transmitting the electronic document to the search engine system (*col.7, lines 28-40 and col.9, lines 1-16*).

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- c. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the feature from Kirsch in the system of Judd because it would have provided the capability for establishing a collection search engine that is responsive to a user query against a collection of documents to provide a search report.

As to claim 26

Judd teaches customizing the electronic document, wherein the customizing is based at least in part upon the contents of the index characteristics of one or more the search engine systems (*col.10, lines 19-44*).

As to claim 27

It incorporates the same limitations as in claim 15 above, and is rejected along the same rationale.

As to claim 19

It is directed to a system for performing the method of claim 25 above, and is rejected along the same rationale. Additionally, Judd further recites a web server connected to a network (*see fig.1 and the accompanying text beginning at col.5, line 62*), said web server operable to manage a content owner's secure graphical or audio objects including granting and denying access to secure content requesters, wherein search engine systems are denied access to said objects (*col.3, lines 21-45*).

As to claims 20-21

They incorporate the same limitations as in claims 26-27 above, and are rejected along the same rationale.

As to claims 22-24

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They incorporate the same limitations as in claims 5, 8 & 10 above, and are rejected along the same rationale.

Response to Arguments

8. Applicant's arguments filed 09/09/2005 have been fully considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Messerly et al. U.S. Patent No. 6,161,084 issued: Dec. 12, 2000

Shoroff et al. U.S. Patent No. 6,381,602 issued: Apr. 30, 2002

Dietz U.S. Patent No. 6,823,341 issued: Nov. 23, 2004

Windhouwer et al., "Acoi: A System for Indexing Multimedia Objects", XP-002165123, pp.1-10.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136.

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The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MN

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
10/30/2005